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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,363	09/26/2003	John William Miller	06459 USA	3026

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EXAMINER	
COONEY, JOHN M	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/672,363	MILLER, JOHN WILLIAM	
	Examiner	Art Unit	
	John m. Cooney	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *2-5 and 18-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,6-17 and 21-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's arguments filed 4-18-06 have been fully considered but they are not persuasive.

Rejection under 35 USC 102 is withdrawn in light of applicants' amendment.

The following rejection is maintained with new claims 25-30 being added:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 6-17 and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al.('432) in view of Bogdan et al.(6,086,788).

Blum et al. discloses preparations of polyurethane foams which can be prepared by combining polyisocyanate, polyol, ethylene glycol monobutyl ether, halohydrocarbon blowing agents such as methylene chloride, catalysts, and surfactants which read on the products and processes of applicants' claims(see abstract, column 13 lines 16-23, column 14 line 30, examples 5 & 6, and the claims, as well as, the entire document).

Blum et al. differs from applicants' claims in that it does not disclose employment of amounts of ethylene glycol monobutyl ether in amount values as claimed. However, Blum et al. does disclose variation in the amount of ethylene glycol monobutyl ether for purposes of controlling dissolution of catalyst(see again Examples 3 and 5). Accordingly, it would have been obvious for one having ordinary skill in the art to have

controlled the amount of ethylene glycol monobutyl ether employed in the preparations of Blum et al. for the purpose of controlling catalyst dissolution effects in the preparations formed in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. It has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller,* 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch,* 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Blum et al. differs from applicants' claims in that it does not specifically require the presence of the hydrohalocarbon blowing agents of applicants' claims. However, Blum does teach employment of heat evaporative blowing agents within its teachings (see column 13 lines 16-28). Further, Bogdan et al. discloses the particular halocarbon blowing agents of applicants' claims to be well known useful blowing agents in the polyurethane foam art for the purpose of providing foam forming effects (see column 1, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the blowing agents of Bogdan et al. as the heat evaporable blowing agents in the preparations of Blum et al. for the purpose of

imparting their foaming effects in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicants' arguments have been considered, but rejection is maintained for the reasons set forth above. As set forth in the rejection above, employment of ethylene glycol monobutyl ether for dissolution of catalyst is sufficient evidence that ethylene glycol monobutyl ether is a variable which achieves a recognized result of dissolving catalyst. Rejection is proper as set forth above, and applicants have not demonstrated unexpected results commensurate in scope with the scope of their claims associated with differences indicated in the rejection above.

Applicants' arguments have been considered as to the additional secondary reference. However, this secondary reference is looked to in order to remedy the deficiencies indicated in the rejection above. Applicants' arguments do rebut examiner's position in regards to this component of the rejection, and combination is maintained to be proper as set forth above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6-17 and 21-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,921,779. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 6,921,779 disclose compositions useful in polyurethane foam synthesis and the manufacture of such from the claims and enabling disclosure of 6,921,779 in order to arrive at the products and processes of applicants' claims would have been obvious for the purpose of achieving the desired polyurethane foam forming effect. The additional species of the claims not particularly recited by the claims of 6,921,779 are equivalent variants which would have been obvious to one of ordinary skill in the art.

Applicants' indication that address will be deferred until allowable subject matter is indicated is noted and acceptable.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Arnason et al. is retained as art of interest for its disclosure of the related use of ethylene glycol monobutyl ether as a solvent in the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700